



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,832	11/17/1999	CLEMENT LAWSON	2870/192	5091

7590

05/06/2003

KAREN A. LOWNY, ESQ
ESTEE LAUDER COMPANIES
125 PINELAWN ROAD
MELVILLE, NY 11747

EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/06/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/441,832

Applicant(s)

LAWSON ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-26 are pending. The Amendment filed 3/19/03, Paper No. 22, amended claims 4, 8, 21 and 24.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 3/19/03 (Paper No. 22) to the rejection of claims 1-26 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Arguments and Amendment to the claims filed 3/19/03, Paper No. 22, are persuasive-in-part to overcome the 35 USC 112 rejections in the previous Office Action. Specifically, the amendment to claims 8 and 21 is sufficient to overcome the 35 USC 112 rejection over the Markush language of claims 8 and 21.

112 Rejection Maintained

The rejection of claims 1, 4-5, 7-8, 15-16, 20-21 and 24 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed 12/18/02, Paper No. 21, and those found below.

Regarding the term "derivative", Applicant argues, Applicants attach herewith copies of examples of claims using the term "derivative" in the context of cholesterol as one of ordinary skill in the art would understand its use". This argument is not persuasive. First, the Examiner respectfully points out that the prosecution of every patent Application is distinct. Second, the Examiner respectfully points out that the term "derivative" in the instant Application is not defined and that the term has not been shown to have a definite art recognized definition. Thus, the rejection of claims 1, 15 and 16 over the term "derivative" is maintained.

Art Unit: 1617

Regarding, the term “based”, Applicant argues, “The use of the work “based” following materials such as carbohydrates, sucrose and glucose is commonly used and known”. This argument is not persuasive. For example, what is carbohydrate-based? It is a carbohydrate compound? It is something that is similar to a carbohydrate? What chemical compounds or modification are encompassed by the term “based”. Regarding US 5,616,359, the Examiner again reminds Applicant that the prosecution of every patent Application is distinct. Thus, the rejection of claims 4, 5, 7, 20, 24 over the term “based” is maintained.

The rejection of claims 8 and 21 as being indefinite for containing “glycerol monostearate” when the claims are directed toward carbohydrate-based surfactant/emulsifier, is maintained. Applicant has provided no arguments against this rejections.

103 Rejection Maintained

The rejection of claims 1-4, 6-11, 14-18, 21-23 and 25 under 35 U.S.C. 103(a) as being unpatentable over US 5,567,420 is MAINTAINED for the reasons set forth in the Office Action mailed 12/18/02, Paper No. 21, and those found below.

The rejection of claims 1, 2, 4, 6-11, 14-17, 21-23 and 25 under 35 U.S.C. 103(a) as being unpatentable over US 5,747,049 is MAINTAINED for the reasons set forth in the Office Action mailed 12/18/02, Paper No. 21, and those found below.

The rejection of claims 5, 12, 13, 19, 20 and 24 under 35 U.S.C. 103(a) as being unpatentable over US ‘420 or US ‘049 each as applied to claims 1-4, 6-11, 14-18, 21-23 and 25 above, and further in view of US 5,741,499 is MAINTAINED for the reasons set forth in the Office Action mailed 12/18/02, Paper No. 21, and those found below.

The rejection of claims 12 and 26 under 35 U.S.C. 103(a) as being unpatentable over US ‘420 or US ‘049 each as applied to claims 1-4, 6-11, 14-18, 21-23 and 25 above, and further

Art Unit: 1617

in view of US 5,393,526 is MAINTAINED for the reasons set forth in the Office Action mailed 12/18/02, Paper No. 21, and those found below.

The rejection of claims 4-6 and 20-22 under 35 U.S.C. 103(a) as being unpatentable over US '420 or US '049 each as applied to claims 1-4, 6-11, 14-18, 21-23 and 25 above, and further in view of US 5,002,680 is MAINTAINED for the reasons set forth in the Office Action mailed 12/18/02, Paper No. 21, and those found below.

Applicant argues, "a mixture of any ingredients taught in the '420 reference will not combine to make the non-emulsion mousse-textured composition of the present invention. A non-emulsion composition containing an alkali metal salt in combination with substantially no oil is not taught in the '420 reference". This argument is not persuasive. The Examiner respectfully points out that '420 clearly teaches that their composition can be in the form of a mousse, which is a "non-emulsion mousse-textured composition". The Examiner further points out that oils are not taught as a major ingredient in the composition of '420, but are taught as additives. Furthermore, exemplifications of the composition of '420 contain substantially no oil.

Applicant argues, "the '420 reference fails to selectively pluck out of the multitudes of ingredients that are suggested as being added as ingredients in the '401 lotion (emulsions) the ones of the present invention, nor does it teach or suggest that these particularly selected ingredients combine to make a non-emulsion mousse-textured composition like that of the present invention". This argument is not persuasive. First, the Examiner respectfully points out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art.

Art Unit: 1617

In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). The '420 reference is not limited to lotions forms, but also teaches mousse forms. Second, the Examiner respectfully points out that the invention of '420 is directed toward color indicators and teaches water as a carrier for such indicators. The other ingredients of the instant invention are taught as emollients and emulsifiers that can be added to the composition to prevent or relieve dryness and to provide uniform blending of ingredients of the composition. Furthermore, the Examiner directs the Applicant to Col. 9 of '420, which states, "The ingredients described above. . . are well known to those skilled in the art. The determination of which ingredients to use to obtain the intended formulations, and the determination of the amounts which may be used to achieve the intended functions and effects of these ingredients are well within the capabilities of those skilled in the art without the need for undue experimentation".

Applicant argues, "the purpose of the '420 reference is to make a lotion whereas the purpose of the present invention is to make a non-emulsion mousse-textured composition. This argument is not persuasive. Again, the Examiner respectfully points out it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re

Art Unit: 1617

Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). While '420 exemplifies a lotion formulation, the reference teaches mousse formulations as compositions of their invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Application/Control Number: 09/441,832

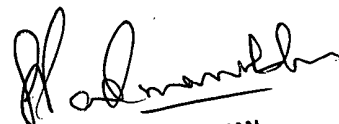
Page 7

Art Unit: 1617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

April 23, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER

5/4/03